

## **REMARKS**

### **I. INTRODUCTION**

Claims 5-14, 16, 18-34, 37-39, 41, 45-48, 50, and 52-75 are pending. Claims 56, 62, and 75 are independent claims. Claim 56 has been amended. No claims have been cancelled in this paper.

In the Office Action, the Examiner rejected claims 62-75 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Further, the Examiner rejected claim 56 and the claims depending therefrom under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. All pending claims were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Pat. Pub. No. 2007/0156677 ("Szabo").

The Examiner did not provide any response to Applicants' arguments, in their paper dated February 3, 2009, traversing the Section 102 rejection based on Szabo. Instead, the Examiner stated that those arguments had "been considered but were moot in view of the new ground(s) of rejection." (Office Action, page 7.) However, the grounds of the Section 102 rejection in the present Office Action are identical to the grounds of the Section 102 rejection addressed in Applicants' February 3, 2009, paper. Therefore, the Examiner is respectfully requested to address these arguments, generally repeated in the present paper, in a new, non-final Office Action.

In view of the following arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2).

### **II. SECTION 112 REJECTIONS**

The Examiner rejected claims 62-75 under Section 112, first paragraph, because those claims recite a "computer readable medium," although that term does not explicitly appear in the specification. (Office Action, pages 2-3.) However, the written description requirement does not require that the exact words of the claims appear in the Specification. As the MPEP explains, "[a]n

objective standard for determining compliance with the written description requirement is, 'does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.'" (MPEP § 2163.02 (*quoting In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)).

Here, Applicants' Specification discloses a server 118 (Fig.1, paragraphs 148, 151-152). Further, the server 118 includes instructions 120. (Specification, paragraphs 153-154.) The instructions may be "the various applications, computer programs, and associated files used to support the logic of the system 100 necessary for the functioning of the system 100." Specification, paragraph 154.) One of ordinary skill would have easily recognized that such instructions could not operate on the server without being stored on a computer readable medium. Therefore, one of ordinary skill would have understood Applicants to have disclosed a computer readable medium.

For at least the foregoing reasons, the Section 112 rejection of Applicants' claims must be withdrawn.

### **III. SECTION 101 REJECTIONS**

The Examiner rejected claim 56 and all claims depending therefrom as allegedly non-statutory under Section 101. Claim 56 has now been amended to recite steps performed "in a computer server." Therefore, claim 56 is now tied to a particular machine, and the Section 101 rejection of claim 56 and all claims depending therefrom must be withdrawn.

### **IV. SECTION 102 REJECTIONS**

#### **A. "position adjustment factor"**

Claim 56 recites in part "influencing the position adjustment factor by a per-hit fee associated with the affiliated listing." The Examiner cited paragraph 35 of Szabo as allegedly disclosing the foregoing recitation. (Office Action, page 5.) At most, Szabo discloses a database access system where "access fees are calculated on the number of documents." (Szabo, ¶ 0035.) Nowhere does Szabo teach or suggest "influencing the position adjustment factor by a per-hit fee associated with the affiliated listing" as recited by independent claim 56.

Szabo discloses

An improved human user computer interface system, wherein a user characteristic or set of characteristics, such as demographic profile or societal "role", is employed to define a scope or domain of

operation. The operation itself may be a database search, to interactively define a taxonomic context for the operation, a business negotiation, or other activity. After retrieval of results, a scoring or ranking may be applied according to user define criteria, which are, for example, commensurate with the relevance to the context, but may be, for example, by date, source, or other secondary criteria. A user profile is preferably stored in a computer accessible form, and may be used to provide a history of use, persistent customization, collaborative filtering and demographic information for the user. Advantageously, user privacy and anonymity is maintained by physical and algorithmic controls over access to the personal profiles, and releasing only aggregate data without personally identifying information or of small groups.

(Szabo, Abstract.) Further, paragraph 35 of Szabo makes clear that access fees in no way relate to a “position adjustment factor”:

Typically, searches and retrievals of information from the discrete databases are subject to specific access fees determined based on the relative commercial worth of the information maintained in the individual databases. Consequently, access fees are typically calculated on the number of documents that are variously searched, reviewed, and/or retrieved in preparation of a search report from a particular database.

(Szabo, ¶ 35.) Thus, at most Szabo discloses that “access fees are calculated on the number of documents,” but nowhere does Szabo in any way teach or suggest that his “access fees” in any way relate to position, let alone “influencing the position adjustment factor.” A “relative commercial worth” used to determine an “access fee” has nothing to do with a “position” or a “position adjustment factor.” Accordingly, Szabo’s “access fees” fail to teach or suggest “influencing the position adjustment factor by a per-hit fee associated with the affiliated listing.”

For at least the aforementioned reasons, Szabo fails to teach or suggest at least these recitations of independent claim 56. For similar reasons, Szabo fails to teach or suggest the recitations of independent claims 62 and 75. Accordingly, the Examiner’s rejections of claims 56, 62, and 75, as well as all claims depending therefrom, should be withdrawn and the claims allowed.

**B. “affiliated listing”**

Moreover, nowhere does Szabo teach or suggest “calculating a position adjustment factor for a listing affiliated with the position adjustment factor, the affiliated listing to be included in the

response at a position” and “using the position adjustment factor to influence the position of the affiliated listing associated with the position adjustment factor among a plurality of listings in the response” as further recited by claim 56. The Examiner cited paragraph 66 of Szabo as allegedly disclosing each of these recitations. (Office Action, page 5.) However Szabo fails to teach or suggest these recitations.

Paragraph 66 of Szabo is a summary of U.S. Pat. No. 5,920,859 (“Li”). According to Szabo, Li “relates to a search engine for retrieving documents pertinent to a query that indexes documents in accordance with hyperlinks pointing to those documents.” (Szabo, ¶ 66.) Specifically,

When a query is entered, the search engine finds all document vectors for documents having the query terms in their anchor text. A query vector is also calculated, and the dot product of the query vector and each document link vector is calculated. The dot products relating to a particular document are summed to determine the relevance ranking for each document.

(Szabo, ¶ 66; quoting Li, Abstract.) Thus, at most Li discloses to determine a relevance ranking, “which a search engine determines . . . in order to limit the number of documents a user must review to satisfy that user’s information needs.” (Li, col. 2, lines 3-7; emphasis added.) Nowhere does Li teach or suggest “calculating a position adjustment factor for a listing affiliated with the position adjustment factor, the affiliated listing to be included in the response at a position,” let alone “using the position adjustment factor to influence the position of the affiliated listings” as further recited by independent claim 56. (Emphasis added.) Accordingly, nowhere does Szabo (or Li) in any way teach or suggest these recitations of claim 56.

For at least the aforementioned reasons, Szabo fails to teach or suggest at least these recitations of independent claim 56. For similar reasons, Szabo fails to teach or suggest the recitations of independent claims 62 and 75. Accordingly, the Examiner’s rejections of claims 56, 62, and 75, as well as all claims depending therefrom, should be withdrawn and the claims allowed.

**C. Dependent Claims 5-14, 16, 18-34, 37-39, 41, 45-48, 50, 52-55 and 57-74**

Claims 5-14, 16, 18-34, 37-39, 41, 45-48, 50, and 52-55 and 57-74 are in condition for allowance at least because they are dependent from one independent claims 56 or 62. Further, the dependent claims also recite independently patentable subject matter, representative examples of which are discussed below.

**D. Claims 5-14, 16, 18-34, 37-39, 41, 45-48, 50, and 52-55**

The Examiner did not set forth any prior art rejections concerning dependent claims 5-14, 16, 18-34, 37-39, 41, 45-48, 50, and 52-55. Therefore, there being no basis for rejecting these claims under Section 112 or Section 101 as discussed above, these claims should be allowed.

**E. Claim 57**

Claim 57 depends from independent claim 56 and recites in part “wherein calculating the position adjustment factor includes accessing an advertiser account record.” The Examiner cited paragraph 409 of Szabo (Office Action, page 6), which states that a search engine may provide a service for “aggregation of many discrete charges for e-commerce, including purchase or leasing of premium information content as well as goods and services,” where these charges may be repaid through “many means, including direct billing.” (Szabo, ¶ 0409.) Additionally, Szabo further states that “advertiser subsidies may be used to offset charges.” (*Id.*) However, nowhere does Szabo’s “aggregation” and payment of charges in any way relate to “calculating the position adjustment factor,” let alone teach or suggest that “calculating the position adjustment factor includes accessing an advertiser account record.” Thus, for at least these reasons, claim 57 is separately patentable.

**F. Claim 58**

Claim 58 depends from independent claim 56 and recites in part “wherein the listings included in the response are not ordered in accordance to a bid amount associated with each listing.” The Examiner cited paragraph 411 of Szabo (Office Action, page 6), which discloses a “‘Backtracker’™ or ‘Session Mapping’™ application” to “[map] the session of each user,” by including “a trail and order of each URLs visited” and “the time spent at each URL” for use as an improvement over a browser “history” function. (Szabo, ¶ 0411.) Szabo states that a “user may be able to retrace his or her path through a map, and that the user will have the ability to hyperlink directly back to a previous stage by a gesture, without resorting to annoying multiple uses of the internet browser ‘back arrow.’” However, Szabo’s web browser history has nothing to do with how listings are ordered, nor does Szabo in any way teach or suggest “wherein the listings included in the response are not ordered in accordance to a bid amount associated with each listing.” (Emphasis added.) Thus, for at least these reasons, claim 58 is separately patentable.

**G. Claim 59**

Claim 59 depends from independent claim 56 and recites in part “further comprising influencing calculating the position adjustment factor by an entity-based characteristic.” The Examiner cited paragraph 393 of Szabo as allegedly disclosing the foregoing recitation. (Office Action, page 6.) Cited paragraph 393 discloses a “Site Mapping™,” wherein “large groups of web sites can be organized . . . into entities having common mapping and navigation characteristics.” (Szabo, ¶ 393; Fig. 17.) Additionally, Szabo discloses that his “Site Mapping™, in effect, provides a familiar, organized overlay to the user as he or she visits different sites with their various contents, organizations, and means of navigation.” (*Id.*) However, nowhere does Szabo in any way indicate “influencing calculating the position adjustment factor” at all, let alone “further comprising influencing calculating the position adjustment factor by an entity-based characteristic.” (Emphasis added.) In contrast, the Examiner appears to have cited paragraph 393 of Szabo solely because the paragraph includes the work “entity.” Thus, for at least these reasons, claim 59 is separately patentable.

## **V. CONCLUSION**

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number Order No. 66703-0016. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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Respectfully submitted,

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